

REMARKS:

Claims 1-10 are pending in the present application. Claims 1-6 and 8-10 are rejected. Claim 7 is objected to. Applicant notes with appreciation that claim 7 would be allowable if rewritten in independent form, including all of the limitations of its base claim and any intervening claims. Applicant has done so. Accordingly, Applicant submits that claim 7 is in condition for allowance.

Claim 1 has been amended, and the limitations of dependent claim 3 have been incorporated within independent claim 1. Additionally, Applicant amends claims 1, 5, 9, and 10 to do one or more of (a) use correct terminology, (b) correct punctuation, or (c) provide proper antecedent basis. The foregoing amendments to the claims are done for purposes of formality only, and should not be construed as limiting the claims.

Claims 1-6 and 10 are rejected under 35 U.S.C. § 102(b) as anticipated by Japanese patent JP 2001-326419 by Naoki ("Naoki").

Claim 1 is directed to an optoelectronic assembly. Claim 1 recites "wherein the optical emitter is mounted on a first substrate ... and wherein the at least one photodetector is mounted on a second substrate."

Naoki is directed to an optical module with waveguides. Beams of incident light are radiated from light sources, are incident to incident faces and then are guided to outgoing faces. (Abstract). The Examiner states that Naoki (figure 2b) discloses an optoelectronic assembly wherein the optical emitter (21) is mounted on a substrate (figure 2b) and at least one photodetector is mounted on a second substrate (figure 2b). (Office Action, page 4).

Applicant respectfully disagrees with the Examiner, and overcomes the rejection of claim 1 as currently amended. In Naoki, the optical emitter (21) is mounted on a substrate (24). However, in Naoki, the at least one photodetector (41) is embedded within an upper cladding layer (29) and a lower cladding layer (28). The lower cladding layer (28) is coupled to the **same substrate (24) as the optical emitter (21)**. Therefore, there is not a **first** substrate and a **second** substrate, as is now claimed in amended claim 1.

Therefore, Applicant submits that Naoki does not expressly or inherently describe all of the elements set forth in claim 1, and thus, Naoki does not anticipate claim 1 or render claim 1 obvious.

Claims 2 and 4-6 and 10 depend from claim 1. By virtue of their dependencies, claims 2 and 4-6 and 10 are patentable over Naoki. The rejection of dependent claim 3 has been made moot by the cancellation of claim 3.

Applicant respectfully requests reconsideration and withdrawal of the section 102(b) rejections of claims 2 and 4-6 and 10.

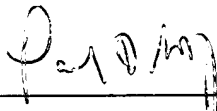
Claims 8 and 9 are rejected under 35 U.S.C. § 103(a) as unpatentable over Naoki in view of U.S. Patent No. 5,774,486 to Jiang et al. ("Jiang"). Jiang does not make up for the deficiencies of Naoki as Naoki relates to claim 1. Therefore, claim 1, and by virtue of their dependencies, claim 8 and 9, are patentable over the cited combination of Naoki and Jiang.

Applicant respectfully requests reconsideration and withdrawal of the section 103(a) rejections of claims 8 and 9.

In view of the foregoing, Applicant respectfully submits that all claims presented in this application patentably distinguish over the prior art. Accordingly, Applicant respectfully requests favorable consideration and that this Application be passed to allowance.

Respectfully submitted,

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Date


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